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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN S. HENDRICKS, ALFRED E. BONNER,
RICHARD E. WUNDERLICH, and ERIC C. BERKOBIN

Appeal 2008-3337
Application 09/158,549
Technology Center 2600

Decided: December 2, 2008

Before KENNETH W. HAIRSTON, JOHN A. JEFFERY,
and CARLA M. KRIVAK, *Administrative Patent Judges*.

KRIVAK, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134 from a final rejection of claims 1, 2, 4-6, 16, 17, 19-21, and 43-45. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

STATEMENT OF CASE

Appellants' claimed invention is a hardware upgrade and method for enhancing the functionality of a set top terminal in a television delivery system. The apparatus and method allow the set top terminal to have electronic mail processing capabilities (Spec. 1:19-21; Abstract).

Independent claim 1, reproduced below, is representative of the subject matter on appeal.

1. A hardware upgrade for enhancing the functionality of a set top terminal in a television program delivery system, each set top terminal adapted to receive electronic mail and having a microprocessor, the hardware upgrade comprising:

an interface for providing an electrical connection to the set top terminal, whereby digital data, including the electronic mail, is transferred from the set top terminal for processing and the processed electronic mail is passed to the set top terminal for display; and

at least one microprocessor connected to said interface for processing the electronic mail to produce processed electronic mail, the microprocessor of the hardware upgrade capable of communicating with the microprocessor of the set top converter through the interface.

REFERENCES

Kauffman	US 5,003,591	Mar. 26, 1991
Lett	US 5,657,414	Aug. 12, 1997
Handelman	US 5,715,315	Feb. 3, 1998

The Examiner rejected claims 1, 2, 4-6, 16, 17, 19-21, and 43-45 under 35 under 35 U.S.C. § 112, first paragraph.

The Examiner rejected claims 1, 2, 4-6, 16, 17, 19-21, and 43-45 under 35 U.S.C. § 103(a) based upon the teachings of Kauffman, Handelman, and Lett.

Appellants contend the Specification fully satisfies the written description and enablement requirements (App. Br. 14; Reply Br. 4) and that Kauffman cannot be combined with Handelman because Handelman does not have an earlier effective filing date than Appellants' effective filing date (App. Br. 14-15).¹ Appellants further contend the claims are not obvious over the combination of Kauffman with Lett (App. Br. 15).

ISSUES

Did the Examiner err in finding that Appellants' Specification does not satisfy the written description and enablement requirements of 35 U.S.C. § 112, first paragraph?

Did the Examiner err in using Handelman in rejecting claims 1, 2, 4-6, 16, 17, 19-21, and 43-45 under 35 U.S.C. § 103(a)?

Did the Examiner err in rejecting claims 1, 2, 4-6, 16, 17, 19-21, and 43-45 under 35 U.S.C. § 103(a) as obvious over the combination of Kauffman and Lett?

FINDINGS OF FACT

1. Appellants' invention is a hardware upgrade that enhances the functionality of a set top terminal to allow for electronic mail processing capabilities (cls. 1, 16, and 45; Abstract).

2. Appellants' parent application filed December 9, 1992, provides a hardware upgrade for a set top terminal that can provide message services (Electronic Mail) (Spec. 25:19-22 of parent 07/991,074) as does

¹ We refer to Appellants' Second Appeal Brief filed July 6, 2007, throughout this opinion.

Appellants' subject application (Spec. 32:27-29). Both applications recite interactive features with interactive services level B menu. Both applications also provide interactive teletext services (Parent Spec. 55:1; Spec. 38:20).

3. Figs. 18 and 20a in Appellants' application show interactive services that include Prodigy and America-on-Line.

4. Kauffman teaches a cable television converter 40 having remotely modifiable functionality. The converter receives firmware downloaded over a cable television network and means for storing the firmware. Other means verify the integrity of the firmware and a processor accesses and executes the firmware to provide converter functions (col. 2, ll. 44-53). The converter can also display information on a user's television set. An email feature can be provided to enable a subscriber to send and receive text messages on the television display (col. 8, ll. 19-30). No separate hardware unit is required for processing electronic mail services (Ans. 11).

5. Handelman teaches a cable television system including an interface unit 18 that receives information such as facsimile, electronic mail, voice mail, etc., which is directly transmitted to a processor 34. The processor provides the data to either an internal memory unit 36 or an external memory unit 38 by way of the controller. The external memory unit can include a memory card 42 and memory card reader (col. 6, ll. 16-28).

6. Lett teaches an auxiliary device for controlling and communicating with peripheral devices from a subscriber terminal (col. 1, ll. 4-8). Lett includes a control microprocessor 128 that controls the overall

operation of the subscriber terminal 40 (col. 7, ll. 35-36). An expansion card 138 includes memory and/or microprocessor components. The microprocessor extends the control microprocessor bus 141 so additional program or data memory, or security can be provided (col. 8, ll. 55-62).

PRINCIPLES OF LAW

Written Description

Drawings alone may be sufficient to satisfy the description requirement of § 112. *See, e.g., Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1564 (Fed. Cir. 1991). Moreover, adequate descriptive support is provided for a recited function if the disclosed device inherently performs that function, even if the specification makes no mention of the function being performed. *See In re Reynolds*, 443 F.2d 384, 389 (CCPA 1971).

As the court stated in *In re Kaslow*, 707 F.2d 1366, 1375 (Fed. Cir. 1983):

The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. The content of the drawings may also be considered in determining compliance with the written description requirement. (Citations omitted)

Although the claimed invention does not necessarily have to be expressed in *ipsis verbis* in order to satisfy the description requirement (*see In re Wertheim*, 541 F.2d 257, 265 (CCPA 1976)), it is nonetheless

necessary that the disclosed apparatus inherently perform the functions now claimed (note *In re Smythe*, 480 F.2d 1376, 1383 (CCPA 1973)).

Enablement

The test regarding enablement is whether the disclosure, as filed, is sufficiently complete to enable one of ordinary skill in the art to make and use the claimed invention without undue experimentation. *See In re Scarbrough*, 500 F.2d 560, 566 (CCPA 1974).

As our reviewing court stated in *In re Wright*, 999 F.2d 1557, 1561 (Fed. Cir. 1993):

Although not explicitly stated in section 112, to be enabling, the specification of a patent must teach those skilled in the art how to make and use the full scope of the claimed invention without “undue experimentation.” . . . Nothing more than objective enablement is required, and therefore it is irrelevant whether this teaching is provided through broad terminology or illustrative examples. [Citations omitted; emphasis ours.]

It is well settled that the examiner has the initial burden of producing reasons that substantiate a rejection based on lack of enablement. *In re Strahilevitz*, 668 F.2d 1229, 1232 (CCPA 1982) and *In re Marzocchi*, 439 F.2d 220, 224 (CCPA 1971). Once this is done, the burden shifts to the appellant to rebut this conclusion by presenting evidence to prove that the disclosure is enabling. *In re Doyle*, 482 F.2d 1385, 1392 (CCPA 1973).

Obviousness

“The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art.” *See In re Kahn*, 441 F.3d 977, 987-88 (Fed. Cir. 2006), *In re Young*, 927 F.2d 588, 591 (Fed. Cir. 1991) and *In re Keller*, 642 F.2d 413, 425 (CCPA 1981).

Section 103 forbids issuance of a patent when “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.”

KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727, 1734 (2007).

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). “[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). If the Examiner’s burden is met, the burden then shifts to the Appellants to overcome the *prima facie* case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. *See In re Oetiker*, 977 F.2d at 1445.

ANALYSIS

Rejection under 35 U.S.C. §112

Written Description

The Examiner rejected claims 1, 2, 4-6, 16, 17, 19-21, and 43-45 as failing to comply with the written description requirement of 35 U.S.C. § 112, first paragraph. The Examiner contends that the limitations in independent claims 1, 16, and 45, are not explicitly found in the Specification of the present application to support the claimed subject matter (Ans. 5). We address this rejection with respect to claim 1 as claims 16 and 45 recite substantially the same features.

The Examiner states the term “electronic mail” is only mentioned on page 32 of Appellants’ subject application and the examples given following that recitation do not pertain to electronic mail (Ans. 5). Thus, adequate written description has not been provided. Appellants assert the contrary.

It is readily apparent from the Examiner’s comments that the Examiner has not considered adequate written description is provided if the claimed device inherently performs a function even if the specification makes no mention of the function being performed. *In re Reynolds, supra*. Appellants’ subject application and the parent application disclose electronic mail provided to a set top. Further, Fig. 20a in Appellants’ subject application and Figs. 3b and 4b in Appellants’ parent application, show interactive services including, in Fig. 20a, Prodigy and America-on-Line (two email services) (FF3). Appellants’ Abstract also provides support for the limitations in claim 1.

Therefore, there is adequate written description in Appellants' Specification for claim 1, independent claims 16 and 45, and the claims depending therefrom.

Enablement

The Examiner rejected claims 1, 2, 4-6, 16, 17, 19-21, and 43-45 as failing to comply with the enabling requirement of 35 U.S.C. § 112, first paragraph. The Examiner contends the subject matter of the claims is not described in the Specification so that an ordinarily skilled artisan could make or use the invention without undue experimentation (Ans. 7). The Examiner again applies this rejection to independent claims 1, 16, and 45. We again address this rejection with respect to independent claim 1, which is representative of the claims.

The Examiner employed the same arguments for this enablement rejection as those used with respect to the written description rejection set forth above. Therefore, the same response as set forth above applies.

We further allow that "[t]he determination of what constitutes undue experimentation in a given case requires the application of a standard of reasonableness, having due regard for the nature of the invention and the state of the art." *See Ex parte Formal*, 230 USPQ 546, 547 (BPAI 1986). Applying this standard of reasonableness, Appellants' subject application specifically recites an email function that is referred to in the Specification, albeit fleetingly, and shown in the drawings. Additionally, teaching a hardware upgrade that allows a set top terminal to receive electronic mail via an interface as recited in claim 1, would not be a stretch to one having skill in the art because the Specification itself states such and the drawings show

the same. Thus, the embodiment of the invention corresponds to the scope of the claimed subject matter.

We find that the Examiner has not successfully demonstrated that one ordinarily skilled in this art would not know how to make and use the claimed invention without undue experimentation. Therefore, the burden of proof never passed to Appellants. For essentially the same reasons as set forth by Appellants on page 12 of the Appeal Brief, and for those reasons set forth above, claim 1, independent claims 16 and 45, and the claims depending therefrom, are enabled by Appellants' Specification.

Obviousness

The Examiner rejected claims 1, 2, 4-6, 16, 17, 19-21, and 43-45 under 35 U.S.C. § 103(a) as obvious over Kauffman, Handelsman, and Lett. We address this rejection with respect to representative claim 1, since independent claims 16 and 45 contain substantially the same features as claim 1.

The Examiner contends Kauffman teaches a set top terminal receiving electronic mail and a set top converter that allows an interactive two-way CATV system. The converter includes a microprocessor. Kauffman, however, does not disclose a separate hardware unit for processing electronic mail services (Ans. 11). The Examiner then cites Handelsman as teaching electronic mail may be transmitted from the CATV interface to an external memory unit. This allows electronic mail to be retrieved from the external memory, passed through the set top terminal and displayed on the TV receiver (Ans. 11-12). However, Handelsman does not teach the "claimed at least one microprocessor connected to the interface for processing the e-mail" (Ans. 12). The Examiner cites Lett for teaching an

expansion card in a subscriber terminal. The expansion card includes a microprocessor and therefore, one ordinarily skilled in the art could combine Kauffman, Handelman, and Lett to obtain the present invention (Ans. 12).

Appellants assert that Handelman is not a prior art reference because Appellants' parent application fully supports the claims under 35 U.S.C. § 112, first paragraph. Appellants' parent application has an effective filing date of December 9, 1992, which is earlier than the earliest effective filing date of Handelman, which is September 15, 1993. As set forth above, the specification meets all the requirements of 35 U.S.C. § 112, first paragraph. Thus, Appellants are correct that Handelman is not a proper prior art reference.

Because the Examiner relies on Handelman as the link between Kauffman and Lett, Appellants state that the combination of Kauffman and Lett would not result in the present invention. Kauffman provides a system where the converter is remotely modifiable by a firmware upgrade. Lett provides an auxiliary device control having a bidirectional communication and an interface between the subscriber terminal and one or more auxiliary devices (App. Br. 15). Further, Kauffman teaches a set top converter for processing email without an external interface unit (FF4). Lett teaches an external memory card including a processor but it does not process email (FF6). There is no teaching or suggestion in either of these references to employ two processors—one in the interface and one in the hardware upgrade—for handling electronic mail.

Thus, Handelman is not a proper reference, and the combination of Kauffman and Lett fails to teach or suggest Appellants' invention. Claim 1,

along with claims 16, 45, and the claims depending therefrom, is not obvious over the combination of Kauffman and Lett.

CONCLUSION

The Examiner erred in rejecting claims 1, 2, 4-6, 16, 17, 19-21, and 43-45 under 35 U.S.C. § 112 and under 35 U.S.C. § 103(a).

DECISION

The Examiner's decision rejecting claims 1, 2, 4-6, 16, 17, 19-21, and 43-45 under 35 U.S.C. § 112, first paragraph, is reversed.

The Examiner's decision rejecting claims 1, 2, 4-6, 16, 17, 19-21, and 43-45 under 35 U.S.C. § 103(a) is reversed.

REVERSED

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